

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES



Re: Application of: **GREVE**
Serial No.: 10/576,860
Filed: April 21, 2006
For: **PROTECTION FROM UNDESIREABLE MESSAGES**
Art Unit: 2157
Examiner: Ho T. Shiu
Customer No.: 23280

Mail Stop: APPEAL
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

September 22, 2008

APPELLANT'S BRIEF UNDER 37 C.F.R. § 41.37

Sir:

Appellant submits this brief for the consideration of the Board of Patent Appeals and Interferences (the "Board") in support of their appeal of the Final Rejection dated April 15, 2008 in this application. The statutory fee of \$510.00 is paid herewith.

09/24/2008 WABDEI1 00000043 10576860
02 FC:1402

1. REAL PARTY IN INTEREST

The real party in interest is 1 & 1 Internet AG, a German corporation having a place of business in Montabaur, Germany, the assignee of the entire right, title and interest in the above-identified patent application. The invention was assigned by inventor Michael Greve to 1 & 1 Internet AG. The assignment to 1 & 1 Internet AG was recorded on January 25, 2007 at reel 018836, frame 0187.

2. RELATED APPEALS AND INTERFERENCES

Appellant, their legal representatives, and assignee are not aware of any appeal, interference or judicial proceeding that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.

3. STATUS OF CLAIMS

Claims 1 to 25 were cancelled. Claim 26 is pending. Claim 26 has been finally rejected as per the Final Office Action dated April 15, 2008.

The rejection to claim 26 is thus appealed. A copy of appealed claim 26 is attached hereto as Appendix A.

4. STATUS OF AMENDMENTS AFTER FINAL

No amendments after final have been made. An advisory action was issued on July 18, 2008. A Notice of Appeal was filed on July 7, 2008.

5. SUMMARY OF CLAIMED SUBJECT MATTER

Independent claim 26 recites a method of monitoring messages addressed to a first receiver (E1) (i.e. paragraph 12; lines 1 to 2) in which the first receiver (E1) is a first set-up user account in a communications service (i.e. paragraph 14; lines 1 to 4) and comprises an undesirable receiving device (UNE), (i.e. paragraph 16; lines 1 to 4), the first receiver (E1) is set up to prevent access by a user of the first receiver (E1) to the

FORM PTO-1083
Mail Stop: APPEAL
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450



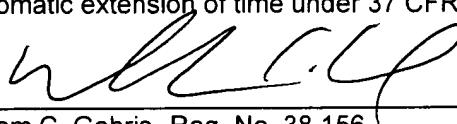
Docket No.: 5048.1004
Date: September 22, 2008

In re application of: **GREVE**
Serial No.: 10/576,860
Filed: April 21, 2006
For: **PROTECTION FROM UNDESIRABLE MESSAGES**

Sir:

Transmitted herewith is a **Appellant's Brief under 37 C.F.R. 41.37 (9 pages)** in the above-identified application.

- Also transmitted herewith are:
 - Petition for extension under 37 C.F.R. 1.136
 - Other: **Return Receipt Postcard**
- Check(s) in the amount of **\$630.00** is/are attached to cover:
 - Filing fee for additional claims under 37 C.F.R. 1.16
 - Petition fee for extension under 37 C.F.R. 1.136
 - Other: **Appeal filing fee under 37 C.F.R. 41.20(b)(1)**
 - Other:
- The Assistant Commissioner is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 50-0552.
 - Any filing fee under 37 C.F.R. 1.16 for the presentation of additional claims which are not paid by check submitted herewith.
 - Any patent application processing fees under 37 C.F.R. 1.17.
 - Any petition fees for extension under 37 C.F.R. 1.136 which are not paid by check submitted herewith, and it is hereby requested that this be a petition for an automatic extension of time under 37 CFR 1.136.



William C. Gehris, Reg. No. 38,156

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue, 14th Floor
New York, New York 10018
Tel: (212) 736-1940
Fax: (212) 736-2427

I hereby certify that the documents referred to as attached therein and/or fee are being deposited with the United States Postal Service as "first class mail" with sufficient postage in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on September 22, 2008.

DAVIDSON, DAVIDSON & KAPPEL, LLC

BY: 
Shelia Cockburn

undesirable receiving device (UNE), (i.e. paragraph 17; lines 2 to 5),
an undesirable message category is defined which indicates messages which are to be prevented
from being delivered to a user of the first receiver (E1), (i.e. paragraph 17; lines 2 to 5),
it is checked whether a message (M) addressed to the first receiver (E1) falls into the undesirable
message category, (i.e. paragraph 17; lines 1 to 13)
the message (M) is allocated to the undesirable receiving device (UNE) if the message (M) falls
into the undesirable message category (i.e. paragraph 17; lines 1 to 13), and
the first receiver (E1) is set up in order that the undesirable receiving device (UNE) can only be
accessed by a second receiver (E2) (i.e. paragraph 24; lines 7 to 13), which is a second set-up
user account in the communications service. (i.e. paragraph 15; lines 1 to 8).

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claim 26 was rejected under 35 U.S.C. §102(b) as being anticipated by Bandini et al. (US 2002/0199095).

7. ARGUMENTS

§102(b) Rejection

Claim 26 was rejected under 35 U.S.C. §102(b) as being anticipated by Bandini et al. (US 2002/0199095).

Bandini et al. discloses a “method for reducing the number of SPAM messages received by users of a protected e-mail network.” (See Bandini para. [0004]; lines 2 to 3).

Claim 26 recites a method of monitoring messages addressed to a first receiver (E1) in which the first receiver (E1) is a first set-up user account in a communications service and comprises an undesirable receiving device (UNE),
the first receiver (E1) is set up to prevent access by a user of the first receiver (E1) to the undesirable receiving device (UNE),
an undesirable message category is defined which indicates messages which are to be prevented from being delivered to a user of the first receiver (E1),
it is checked whether a message (M) addressed to the first receiver (E1) falls into the undesirable message category,
the message (M) is allocated to the undesirable receiving device (UNE) if the message (M) falls into the undesirable message category, and
the first receiver (E1) is set up in order that the undesirable receiving device (UNE) can only be accessed by a second receiver (E2), which is a second set-up user account in the communications service.

Bandini et al. does not disclose “a first receiver (E1) in which the first receiver (E1) is a first set-up user account in a communications service and comprises an undesirable receiving device (UNE)” nor does it teach “the first receiver (E1) is set up to prevent access by a user of the first receiver (E1) to the undesirable receiving device (UNE)” as recited in claim 26.

Examiner for the first time in the Advisory Action asserts that relay (46) is the first receiver (E1). But, the first receiver (E1) requires “a first set-up user account.” Relay (46) clearly is not “a first set-up user account in a communications service” as claimed. Relay (46) is not a user account at all and does not comprise an “undesirable receiving device (UNE)” as claimed. Relay (46) is only a software program that relays information to other devices.

Moreover, the Examiner asserts that paragraph [0038] shows that only the administrator is allowed to view borderline messages. Paragraph [0038] refers to Fig. 4. Fig. 4 and paragraphs [0035], [0038] and [0039] show that the user still has input in forwarding a message as “potential” SPAM. In no way is access by the first receiver (E1) “set up in order that the undesirable receiving device (UNE) can only be accessed by a second receiver (E2), which is a second set-up user account in the communications service” as claimed since unwanted messages that are SPAM are still sent to a user station. (see Bandini paragraph [0019], for example).

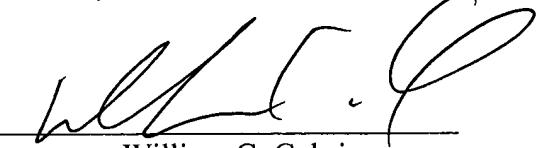
Withdrawal of the rejection under 35 U.S.C. §102(b) to claim 26 is therefore respectfully requested.

CONCLUSION

It is respectfully submitted that the application is in condition for allowance. Favorable consideration of this appeal brief is respectfully requested.

Respectfully submitted,

DAVIDSON, DAVIDSON & KAPPEL, LLC

By: 

William C. Gehris
Reg. No. 38,156

DAVIDSON, DAVIDSON & KAPPEL, LLC
485 Seventh Avenue, 14th Floor
New York, NY 10018
Tel: (212) 736-1940
Fax: (212) 736-2427

APPENDIX A:

**PENDING CLAIM 26 OF U.S.
APPLICATION SERIAL NO. 10/576,860**

Claim 26 (previously presented): Method of monitoring messages addressed to a first receiver (E1) in which the first receiver (E1) is a first set-up user account in a communications service and comprises an undesirable receiving device (UNE),
the first receiver (E1) is set up to prevent access by a user of the first receiver (E1) to the undesirable receiving device (UNE),
an undesirable message category is defined which indicates messages which are to be prevented from being delivered to a user of the first receiver (E1),
it is checked whether a message (M) addressed to the first receiver (E1) falls into the undesirable message category,
the message (M) is allocated to the undesirable receiving device (UNE) if the message (M) falls into the undesirable message category, and
the first receiver (E1) is set up in order that the undesirable receiving device (UNE) can only be accessed by a second receiver (E2), which is a second set-up user account in the communications service.

APPENDIX B

Evidence Appendix under 37 C.F.R. §41.37 (c) (ix):

No evidence pursuant to 37 C.F.R. §§1.130, 1.131 or 1.132 and relied upon in the appeal has been submitted by appellant or entered by the examiner.

APPENDIX C

Related proceedings appendix under 37 C.F.R. §41.37 (c) (x):

As stated in "2. RELATED APPEALS AND INTERFERENCES" of this appeal brief, appellant, their legal representatives, and assignee are not aware of any appeal or interference that directly affects, will be directly affected by, or will have a bearing on the Board's decision in this appeal.